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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,195	08/21/2001	Jonathan Sowler	5181-77401	7715

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EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/934,195

Applicant(s)

SOWLER, JONATHAN

Examiner

Kevin Schubert

Art Unit

2137

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10102003</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

Claims 1-35 have been considered.

***Claim Objections***

5            Claims 6,23, and 29 are objected to because of the following informalities: the phrase  
"comprising one of said first or second parts" should be "comprising one of said first **and** second parts".  
Appropriate correction is required.

             Claims 8 and 10 are objected to because of the following informalities: the phrase "at said  
10    service" in part b) should be "at said **first** service". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for  
the rejections under this section made in this Office action:

15            A person shall be entitled to a patent unless –  
  
             (e) the invention was described in (1) an application for patent, published under section 122(b), by  
             another filed in the United States before the invention by the applicant for patent or (2) a patent  
             granted on an application for patent by another filed in the United States before the invention by the  
20            applicant for patent, except that an international application filed under the treaty defined in section  
             351(a) shall have the effects for purposes of this subsection of an application filed in the United States  
             only if the international application designated the United States and was published under Article 21(2)  
             of such treaty in the English language.

             Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson, U.S. Patent  
25    No. 6,209,095.

As per claims 1,9,13,14,17,24,31, and 34, the applicant describes a method for forming a service  
message for a multi-service environment comprising the following limitations which are met by Anderson:

             a) digitally signing one or more message components for a first part of a service message (Col  
30    11, lines 13-22);

Art Unit: 2137

b) digitally signing one or more message components for a second part of said service message (Col 11, line 66 to Col 12, line 2);

c) forming said service message from said first and second parts, and first and second digital signatures of said first and second parts (Fig 6);

5            Fig 6 represents one embodiment of Anderson's disclosed invention. In this embodiment the service message is a payment message. The first part of the service message is an electronic check from the payer (110 of Fig 6). This part is digitally signed by the payer (126 of Fig 6). The second part of the message is a deposit instrument of the payee (160 of Fig 6) which gives the bank authorization from the payee to make an electronic transaction such as putting money in the payee's account. This part is  
10            digitally signed by the payee (175 of Fig 6).

As per claims 2,21, and 25, the applicant describes the method of claims 1,17, and 24, which are met by Anderson (see above), with the following limitation which is also met by Anderson:

15            Wherein at least one message component is common to both said first and second parts of said service message (Fig 6);

The message component "AMOUNT" is common to both the first part and the second part.

As per claims 3,20, and 26, the applicant describes the method of claims 1,17, and 24, which are met by Anderson (see above), with the following limitation which is also met by Anderson:

20            Further comprising associating one or more message components relating to a first service with each other to form said first part, and associating said one or more message components relating to a second service with each other to form said second part (Fig 6).

25            As per claims 4 and 22, the applicant describes the method of claims 1 and 20, which are met by Anderson (see above), with the following limitation which is also met by Anderson:

Wherein said service message includes one or more message blocks, each comprising one or more message components (Col 10, lines 39-43).

Art Unit: 2137

As per claims 5 and 28, the applicant describes the method of claims 4 and 27, which are met by Anderson (see above), with the following limitation which is also met by Anderson:

Wherein at least one message block is common to both said first and second parts of said service  
5 message (Fig 6);

The "AMOUNT" block is common to both the first and second parts. The applicant should note that all the items listed, such as the "amount", "check number", "memo", etc are blocks (Col 26, lines 8-13).

10 As per claims 6,23, and 29, the applicant describes the method of claims 5,22, and 27, which are met by Anderson (see above), with the following limitation which is also met by Anderson:

Wherein two or more blocks comprising one of said first or second parts of said message are related to each other (Fig 6);

The Payee block (118 of Fig 6) and the Payee Public Key block (119 of Fig 6) are related to each  
15 other.

As per claims 7,18, and 30, the applicant describes the method of claims 1,17, and 24, which are met by Anderson (see above), with the following limitation which is also met by Anderson:

Further comprising forming said service message such that cryptographic data for said service  
20 message is disposed in a separate part of said message from said first and second parts (Fig 6; Col 28, lines 2-15);

The certificates, such as the account certificate (138 of Fig 6) and the bank certificate (138 of Fig 6) are appended to the first part of the service message, the payer-signed electronic check (110 of Fig 6). The certificates represent cryptographic data disposed in a separate part of the service message from the  
25 first part, the payer-signed electronic check, and the second part, the payee-signed deposit instrument.

Art Unit: 2137

As per claims 8,10,11,12,15,16,32,33, and 35, the applicant describes a method for decoding a service message comprising first and second parts respectively associated with first and second services of a multi-service environment comprising the following limitations:

- a) receiving said service message at a first service (Col 12, lines 20-28);
- 5        b) verifying only said first part of said message at said service (Col 12, lines 20-28);
- c) receiving said service message at a second service (Col 12, lines 20-28);
- d) verifying only said second part of said service message at said second service (Col 12, lines 20-28);

10        The first and second services are applicable to a wide range of organizations. In the example given the first service is the payee and the second service is a bank. However, the invention is also applicable to a number of third party organizations. One important feature of the invention is that first and second parts of the invention are independent of each other and can be received and verified independently of each other as well (Col 16, lines 1-6).

15        As per claims 19 and 27, the applicant describes the electronic signal of claims 17 and 24, which are met by Anderson (see above), with the following limitation which is also met by Anderson:

Wherein said first part of said message is associated with a first service, and said second part of said message is associated with a second service (Col 39, lines 21-39);

20        In another embodiment, the first and second parts are first and second doctor's signatures (Col 39, lines 21-39). The first service could be the first database (570 of Fig 26) which logs and verifies only the first doctor's signature, or first part of the message. The second service could be the second database (572 of Fig 26) which logs and verifies only the second doctor's signature, or second part of the message. Additionally, the first and second services may be insurance companies or administrators which may need to verify only one part of the service message.

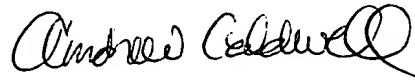
Art Unit: 2137

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 8:00-5:00.

5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**ANDREW CALDWELL**  
**SUPERVISORY PATENT EXAMINER**